

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.114 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 7 has been canceled, and each of claims 1, 11 and 15 has been amended to incorporate the features of claim 7 therein. Claims 16, 19 and 20 have been amended for readability purposes to replace the phrase “a pixel area” with “an area of a pixel”. Claims 19 and 20 have been amended in conformance with standard U.S. claims drafting practice by replacing “having” and “wherein” with “comprising”. Claim 20 has further been amended for readability purposes. Entry of the above amendments is proper at least because a Request for Continued Examination is being filed herewith. See 37 C.F.R. §1.114.

In the Official Action, claims 7, 16, 19 and 20 stand rejected under 35 U.S.C. §112, second paragraph, for the reason set forth at page 2 of the Official Action. In particular, the Examiner has taken the position that the meaning of the term “pixel area” is unclear. Applicants submit that one of ordinary skill in the art would quite clearly understand that the term “a pixel area” as recited in the claims refers to an area of a pixel. In order to expedite prosecution, claims 16, 19 and 20 have been amended for readability purposes to reflect the already understood meaning of the term “pixel area”.¹ Accordingly, for at least the above reasons, withdrawal of the §112 rejection is respectfully requested.

Claims 1, 4, 7, 11, 14, 15 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Document No. 2000-114773 (*JP* ‘773). Withdrawal of this rejection is respectfully requested for at least the following reasons.

¹ Claim 7, which also stands rejected, has been canceled by the above amendments. Claims 1, 11 and 15 which have been amended to incorporate the features of claim 7, recite the term “an area of a pixel”.

According to one aspect defined by claim 1, an electromagnetic-wave-shielding film is provided, comprising a transparent support and a conductive layer comprising a metal thin film in the form of a mesh film, wherein the mesh film comprises lattice lines which define at least a quadrilateral unit space and another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, wherein a unit space area of the mesh film is two fifths or less of an area of a pixel of an image display device.

According to additional aspects, claim 11 is directed to a method of producing an electromagnetic-wave-shielding film, and claim 15 is directed to an image display device.

JP '773 relates to a front-surface filter, a lattice-like conductor for anti-moire which is pasted on a glass or resin film, or it is directly printed, or a metal foil is pasted on the resin film to manufacture a panel with high electromagnetic wave shielding characteristics (abstract).

JP '773 does not disclose each feature of one aspect defined by claim 1, and as such fails to constitute an anticipation of such claim. For example, *JP '773* does not disclose an electromagnetic-wave-shielding film, wherein a unit space area of a mesh film is two fifths or less of an area of a pixel of an image display device, as recited in claim 1. In this regard, the Patent Office has asserted that Figure 5 of *JP '773* shows a mesh film which inherently possesses a unit space area that is two fifths or less of a pixel area of an existing image display device (Official Action at page 3). Contrary to such assertion, *JP '773* does not contain any disclosure of the area of a pixel of an image display device. As such, it is clear that the Patent Office has not met its burden of showing with certainty that the *JP '773* product possesses the recited relationship between the unit space area of the mesh film and the area of a pixel of the image display device.

In this regard, it is well established that in order for prior art to anticipate a claimed invention based on an inherent feature, the inherency must be certain. Ex parte Cyba, 155 USPQ 756 (POBA 1966). The fact that a prior art article "may" inherently have the characteristics of the claimed product is not sufficient. Ex parte Skinner, 2 USPQ2d 1788 (BPAI 1986). Inherency must be a necessary result and not merely a possible result. In re Oelrich, 212 USPQ 323 (CCPA 1981). Moreover, the Patent Office must provide some evidence or scientific reasoning to establish the reasonableness of such belief before Applicants can be put through the burden of demonstrating that the subject matter of the prior art does not possess the characteristics relied upon. Ex parte Skinner, 2 USPQ2d 1788, 1789 (BOPA 1986). In the present case, the Patent Office has not established inherency of Applicants' claimed features with the requisite certainty. As such, it is apparent that *JP '773* does not anticipate claim 1.

For the same reasons discussed above, *JP '773* does not disclose that a unit space area of a mesh film is two fifths or less of an area of a pixel of an image display device, as recited in each of claims 11 and 15. As such, *JP '773* fails to constitute an anticipation of claims 11 and 15.

Accordingly, for at least the reasons discussed above, withdrawal of the §102(b) rejection based on *JP '773* is respectfully requested.

Claims 2-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over *JP '773*. Claims 8-10, 16 and 17 stand rejected under 35 U.S.C. §103(a) as being obvious over *JP '773*. These rejections are moot in light of the above amendments of claims 1 and 15 to incorporate the features of claim 7 therein. In this regard, claim 7 has not been rejected in the above §103(a) rejections. Accordingly, withdrawal of the above rejections is respectfully requested.

Claim 19 stands rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Document No. 11-184384 (*JP '384*) or under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,150,754 (*Yoshikawa et al '754*). The Patent Office has indicated that *JP '384* and *Yoshikawa et al '754* belong to the same patent family, and has relied on the disclosure of *Yoshikawa et al '754* (Official Action at page 4). Withdrawal of the above rejection is respectfully requested for at least the following reasons.

According to one aspect defined by claim 19, an electromagnetic-wave-shielding film is provided, comprising a transparent support and a conductive layer composed of a metal thin film, wherein the conductive layer is composed of a mesh film in which random mesh portions are formed, wherein a unit space area of the mesh film is two fifths or less of an area of a pixel of an image display device.

Yoshikawa et al '754 relates to an electromagnetic-wave-shielding and light transmitting plate suitable for a front filter of a plasma display panel (col. 1, lines 7-9).

Yoshikawa et al '754 does not disclose each feature of one aspect defined by claim 19, and as such fails to constitute an anticipation of such claim. For example, *Yoshikawa et al '754* does not disclose an electromagnetic-wave-shielding film, wherein a unit space area of the mesh film is two fifths or less of an area of a pixel of an image display device, as recited in claim 19. In this regard, it appears that the Patent Office has taken the position that such feature is inherently disclosed in Figure 5 of *Yoshikawa et al '754*.² However, *Yoshikawa et al '754* fails to contain any disclosure of the area of a pixel of an image display device, let alone the recited relationship between the unit space area of the mesh film and the area of a pixel of an image display device.

² In support of the §102 rejection based on *JP '384* and *Yoshikawa et al '754*, the Patent Office has relied on Figure 5 of "the Kawamoto reference" (Official Action at page 4). Such mention of the Kawamoto reference appears to be in error.

As discussed above, the Patent Office bears the burden of establishing with certainty that the prior art possesses an allegedly inherent feature. In the present case, the Patent Office has not provided any evidence or scientific reasoning to show that *Yoshikawa et al* '754 inherently discloses that a unit space area of the mesh film is two fifths or less of an area of a pixel of an image display device, as recited in claim 19.

For at least the above reasons, it is apparent that *Yoshikawa et al* '754 does not constitute an anticipation of claim 19. Accordingly, withdrawal of the above §102(b)/§102(e) rejection is respectfully requested.

Claims 1-6, 9-11, 15, 17, 18 and 20 stand rejected under 35 U.S.C. §103(a) as being obvious over *JP* '384 or *Yoshikawa et al* '754. As discussed above, the Patent Office has indicated that *JP* '384 and *Yoshikawa et al* '754 belong to the same patent family, and has relied on the disclosure of *Yoshikawa et al* '754. Withdrawal of this rejection is respectfully requested for at least the following reasons.

Yoshikawa et al '754 fails to disclose or suggest each feature of aspects defined by claims 1, 11 and 15. For example, *Yoshikawa et al* '754 fails to disclose or suggest lattice lines which define at least a quadrilateral unit space and another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, as recited in claims 1, 11 and 15. In this regard, the Patent Office has asserted that modifying *Yoshikawa et al* '754 to employ the recited lattice lines would merely have been "a matter of choice" (Official Action at pages 8 and 9). However in making such assertion, the Patent Office has impermissibly relied on an "obvious to try" rationale in an attempt to cure the deficiency of *Yoshikawa et al* '754.

It is well established that the Patent Office bears the burden of showing that the prior art discloses or suggests each claimed feature. See M.P.E.P. §2143. In the present case,

Yoshikawa et al '754 fails to disclose or suggest lattice lines which define at least (1) a quadrilateral unit space and (2) another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, as recited in claims 1, 11 and 15.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness has been established with respect to claims 1, 11 and 15 based on *Yoshikawa et al '754*.

According to another aspect as defined by claim 20, an image display device is provided, comprising an electromagnetic-wave-shielding film, comprising a transparent support and a conductive layer composed of a metal thin film, wherein the electromagnetic-wave-shielding film is mounted on a front surface of the device, the conductive layer being composed of a mesh film in which random mesh portions are formed, wherein the electromagnetic-wave-shielding film mounted on the front surface, has a unit space area of the mesh film of two fifths or less of an area of a pixel of the image display device, and has random mesh portions in the conductive layer, which are formed by intersecting points obtained by shifting lattice lines of a regular lattice pattern from the original position thereof.

Yoshikawa et al '754 fails to disclose or suggest each feature of one aspect defined by claim 20. For example, *Yoshikawa et al '754* does not disclose or suggest a conductive layer composed of a metal thin film, as recited in claim 20. By comparison, *Yoshikawa et al '754* discloses a conductive composite mesh member which is made by weaving metallic fibers and/or metal-coated organic fibers with transparent fibers, as shown in Figure 2 thereof (col. 4, lines 54-60). Clearly, the conductive composite mesh member disclosed by *Yoshikawa et al '754* is not the same as or suggestive of a metal thin film. Such metallic and/or metal-coated organic fibers woven with transparent fibers cannot properly be considered the same as or suggestive of the claimed metal thin film.

Yoshikawa et al '754 also fails to disclose or suggest a conductive layer comprising a metal thin film in the form of a mesh film, as recited in claims 1, 11 and 15. As discussed above, *Yoshikawa et al '754* merely discloses a composite mesh member formed from woven metallic and/or metal-coated fibers and transparent fibers, which is not the same as or suggestive of the recited metal thin film.

For at least the above reasons, it is apparent that claims 1, 11, 15 and 20 are not rendered *prima facie* obvious by *Yoshikawa et al '754*. Accordingly, withdrawal of the above §103(a) rejection is respectfully requested.

Claims 1 and 8 stand rejected under 35 U.S.C. §103(a) as being obvious over Japanese Patent Document No. 11-266095 (*JP '095*). This rejection is moot in light of the above amendment in which claim 1 has been amended to incorporate the features of claim 7 therein. Claim 7 has not been rejected based on *JP '095*. Accordingly, for at least this reason, withdrawal of the above rejection is respectfully requested.

Claims 11 and 13 stand rejected under 35 U.S.C. §103(a) as being obvious over Japanese Patent Document No. 11-74684 (*JP '684*) and by U.S. Patent No. 6,090,473 (*Yoshikawa et al '473*). The Patent Office has indicated that *JP '684* and *Yoshikawa et al '473* belong to the same patent family, and has relied on the disclosure of *Yoshikawa et al '473* (Official Action at page 13). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Yoshikawa et al '473 relates to an electromagnetic-wave shielding and light transmitting plate and, more particularly, to an electromagnetic-wave shielding and light transmitting plate suitable for a front filter for a plasma display panel (col. 1, lines 5-9).

Yoshikawa et al '473 fails to disclose or suggest each feature of one aspect defined by claim 11. For example, *Yoshikawa et al '473* does not disclose or suggest a unit space area of

a mesh film that is two fifths or less of an area of a pixel of an image display device, as recited in claim 11. In this regard, *Yoshikawa et al '473* fails to contain any disclosure of the area of a pixel of an image display device, let alone the recited relationship between the unit space area of the mesh film and the area of a pixel of an image display device. Absent an improper resort to Applicants' own disclosure, one of ordinary skill in the art would not have been motivated to employ a unit space area of a mesh film that is two fifths or less of an area of a pixel of an image display device, as recited in claim 11.

Furthermore, *Yoshikawa et al '473* fails to disclose or suggest lattice lines which define at least a quadrilateral unit space and another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, as recited in claim 11. In this regard, the Patent Office has asserted that employing the recited lattice lines would merely have been "a matter of choice" (Official Action at page 14). However in making such assertion, the Patent Office has impermissibly relied on an "obvious to try" rationale in an attempt to cure the deficiency of *Yoshikawa et al '473*.

As discussed above, the Patent Office bears the burden of showing that the prior art discloses or suggests each claimed feature. In the present case, *Yoshikawa et al '473* fails to disclose or suggest lattice lines which define at least (1) a quadrilateral unit space and (2) another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, as recited in claim 11.

Accordingly, for at least the above reasons, withdrawal of the above §103(a) rejection is respectfully requested.

Claims 11, 12 and 14 stand rejected under 35 U.S.C. §103(a) as being obvious over Japanese Patent Document No. 2000-114770 (*JP '770*) and U.S. Patent No. 6,210,787 (*Goto et al*). The Patent Office has indicated that *JP '770* and *Goto et al* belong to the same patent

family, and has relied on the disclosure of *Goto et al* (Official Action at page 14).

Withdrawal of this rejection is respectfully requested for at least the following reasons.

Goto et al relates to a surface covering for the screens of display devices, especially plasma displays which need to be guarded against leakage of electromagnetic waves (col. 1, lines 5-8).

Goto et al does not disclose or suggest each feature of one aspect according to claim 11. For example, *Goto et al* does not disclose or suggest a unit space area of a mesh film that is two fifths or less of an area of a pixel of an image display device, as recited in claim 11. In this regard, *Goto et al* fails to contain any disclosure of the area of a pixel of an image display device, let alone the recited relationship between the unit space area of the mesh film and the area of a pixel of an image display device. Absent an improper resort to Applicants' own disclosure, one of ordinary skill in the art would not have been motivated to employ a unit space area of a mesh film that is two fifths or less of an area of a pixel of an image display device, as recited in claim 11.

Furthermore, *Goto et al* fails to disclose or suggest lattice lines which define at least a quadrilateral unit space and another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, as recited in claim 11. In this regard, the Patent Office has asserted that modifying *Goto et al* to employ the claimed lattice lines would merely have been "a matter of choice" (Official Action at page 15). However in making such assertion, the Patent Office has impermissibly relied on an "obvious to try" rationale in an attempt to cure the deficiency of *Goto et al*.

As discussed above, in order for the Patent Office to establish a *prima facie* case of obvious, the prior art must disclose or suggest each claimed feature. Here, *Goto et al* fails to disclose or suggest lattice lines which define at least (1) a quadrilateral unit space and (2)

another unit space having a shape of a regular pentagon, a pentagon, a regular hexagon, a hexagon, a circle or an ellipse, as recited in claim 11.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness exists. Accordingly, withdrawal of the §103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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